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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054408
Party	Plaintiff Hublot of America, Inc.
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Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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HUBLOT OF AMERICA, INC.,	:	
	:	
Petitioner,	:	
	:	
- against -	:	Cancellation No. 92054408
	:	
SOLID 21 INCORPORATED,	:	
	:	
Registrant.	:	
	:	
-----X	X	

**STIPULATED MOTION TO SUSPEND PROCEEDINGS
PENDING RESOLUTION OF CIVIL ACTION**

Pursuant to Trademark Rule of Practice 2.117(a), 37 C.F.R. § 2.117(a), Petitioner Hublot of America, Inc. (“Petitioner”) and Registrant Solid 21 Incorporated (“Registrant”) hereby jointly move the Trademark Trial and Appeal Board (the “Board”) to suspend these proceedings pending termination of a civil action involving the mark at issue herein, RED GOLD.

BACKGROUND

The Petition for Cancellation herein seeks cancellation of Registrant’s Registration No. 2793987 for the mark RED GOLD on the basis that the phrase “red gold” is generic and cannot function to indicate source. That same issue – whether Registrant’s RED GOLD mark is generic and therefore invalid – is at issue in a pending litigation in the United States District Court for the Central District of California.

Registrant instituted a suit against Petitioner in federal court on January 14, 2011, alleging, among other things, trademark infringement of Solid 21’s purported RED GOLD trademark. *See Solid 21, Inc. v. Hublot of America, et al.*, Case No. 2:11-cv-0468-DMG-JC

(C.D. Cal.) (hereinafter, the “Civil Action”). In the Civil Action, Petitioner has denied the salient allegations of the complaint, asserted affirmative defenses including that the Registrant’s purported RED GOLD mark is generic, and asserted counterclaims including one seeking cancellation of Registrant’s RED GOLD trademark on the basis of genericness. Copies of the Complaint and Answer and Counterclaim in the Civil Action are attached as Exhibits A and B hereto.

On January 3, 2014, Petitioner filed a motion (the “Summary Judgment Motion”) in the Civil Action seeking summary judgment on all of Registrant’s claims and Petitioner’s counterclaims. On September 29, 2014, Judge Dolly M. Gee denied the Summary Judgment Motion. On October 29, 2014, Petitioner filed a motion to certify the Summary Judgment Motion for interlocutory appeal (the “Motion for Interlocutory Appeal”), and on November 10, 2014, Petitioner filed a Supplemental Memorandum regarding the Motion for Interlocutory Appeal. The Motion for Interlocutory Appeal was fully briefed as of December 19, 2014, and remains pending.

ARGUMENT

Pursuant to 37 C.F.R. § 2.117, “[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action” *See also* TBMP § 510.02(a). The resolution of the pending Civil Action will bear directly on and may be dispositive of this Cancellation proceeding. Indeed, the Board routinely grants motions to suspend opposition and cancellation proceedings pending the outcome of a pending civil action on the grounds that such actions may be dispositive of the inter partes proceedings. TBMP § 510.02(a); *see also The*

Other Tel. Co. v. Connecticut Nat'l Tel. Co. Inc., 181 U.S.P.Q. 125, 126 (TTAB 1974)

(suspending opposition proceeding during pendency of district court action where Opposer was seeking to enjoin Applicant from using the mark at issue in the opposition proceeding) and cases cited therein.

Here, both the Civil Action and the Opposition relate directly to whether the RED GOLD mark is generic and therefore incapable as functioning as a mark. A decision by the Central District of California or by the Ninth Circuit that the RED GOLD mark is generic will be determinative of the issues raised in the Opposition. Accordingly, a suspension is appropriate pending a final determination in the Civil Action.

CONCLUSION

For the reasons set forth above, the parties jointly move the Board to suspend these proceedings until final resolution of the pending Civil Action between the parties.

Dated: New York, New York
April 28, 2015

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 

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Dated: Los Angeles, California
April 28, 2015

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EXHIBIT A

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Attorneys for Plaintiff
SOLID 21 INC.

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

SOLID 21, INC., a Nevada Corporation
headquartered in Los Angeles, California,

Plaintiff,

vs.

HUBLOT OF AMERICA, a Florida
Corporation; LVMH MOET HENNESSY
LOUIS VUITTON, INC., a Delaware
Corporation; LVMH WATCH & JEWELRY
USA, INC., a Delaware Corporation; LVMH
MOET HENNESSY LOUIS VUITTON S.A.,
a French Corporation; and DOES 1-10,
inclusive,

DEFENDANTS.

CASE NO CV11 468 - JSL (JCL)

COMPLAINT FOR:

1. STATUTORY TRADEMARK INFRINGEMENT;
2. COMMON LAW TRADEMARK INFRINGEMENT;
3. UNFAIR COMPETITION;
4. FALSE DESCRIPTION;
5. INJUNCTIVE RELIEF;
6. DECLARATORY RELIEF

DEMAND FOR JURY TRIAL

Plaintiff SOLID 21 INC. (hereinafter "Plaintiff" and/or "SOLID 21"), a Nevada Corporation with its principal place of business in Los Angeles, California, by and through its

undersigned attorneys, alleges for its Complaint against defendants HUBLOT OF AMERICA, a Florida Corporation; LVMH MOET HENNESSY LOUIS VUITTON, INC., a Delaware Corporation; LVMH WATCH & JEWELRY USA, INC., a Delaware Corporation; their parent company LVMH MOET HENNESSY LOUIS VUITTON S.A., a French Corporation; and DOES 1-10, inclusive, (collectively, "DEFENDANTS") as follows:

I. NATURE OF THE ACTION

1. This is a complaint for Trademark Infringement, Unfair Competition, and False Description arising in Common law and under §§ 32 and 43 of the Lanham Act, 15 U.S.C. §§ 1114(1) (Trademark Infringement) and 1125(a) and (c) (Unfair Competition and False Description), for Unfair Business Practice arising under California Business and Professions Code §§ 14245 et seq. and 17200 et seq., and for declaratory relief (see, 15 U.S.C. § 1065).

2. SOLID 21 is the owner of the registered and incontestable trademark RED GOLD® for, *inter alia*, fine jewelry and watches made from a special alloying of gold with a distinct color made into fine jewelry in connection with the manufacture, marketing and advertising of watches, necklaces, bracelets, rings, anklets, cuff links, ornamental hair pins, belt buckles of precious metal, tie clips and pegs and earrings known as "RED GOLD®." The trademark is capsulated in the following trademark information and in the trademark certificate attached hereto as Exhibit 1 and incorporated herein as though fully set forth:

U.S. Trademark Registration No. 2,793,987

Mark: RED GOLD(R)

Registered: December 16, 2003

Owner: SOLID 21 Incorporated

In addition, on August 21, 2009, the Commissioner of Trademarks, United States Patent and Trademark Office issued the following Notice of Use and Incontestability in regards to Plaintiff's RED GOLD® trademark (a true and correct copy of said Notice of Incontestability is attached hereto as Exhibit 2 and Incorporated herein as though fully set forth):

"The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15

1 of the Trademark Act, 15 U.S.C. §§1058 and 1065. The combined declaration is
2 accepted and acknowledged. The registration remains in force.

3 REG NUMBER: 2793987

4 MARK: RED GOLD®

5 OWNER: Solid 21 Incorporated

6 3. SOLID 21 seeks equitable relief, as well as compensatory and monetary damages, costs
7 and disbursements. (15 U.S.C. §§ 1116 and 1117.) Plaintiff also brings this action for monetary
8 damages it has suffered and disgorgement of DEFENDANTS' profits as a result of
9 DEFENDANTS' unfair competition and intentional violation of Section 43(a) of the Lanham
10 Act, 15 U.S.C. § 1125(a).

11 II. JURISDICTION AND VENUE

12 4. This Court has original subject-matter jurisdiction over this action pursuant to 15 U.S.C.
13 § 1121 and 28 U.S.C. §§ 1331, 1338(a) and 1338(b) because this action involves substantial
14 claims arising under the United States Trademark Act of 1946, as amended, 15 U.S.C. 1051, *et*
15 *seq.*, including claims Trademark Infringement, Unfair Competition, and False Description
16 arising under §§ 32 and 43 of the Lanham Act, 15 U.S.C. §§ 1114(1) (Trademark Infringement)
17 and 1125(a) (Unfair Competition and False Description), for Unfair Business Practice arising
18 under California Business and Professions Code § 17200 *et seq.*, and for injury to business
19 reputation.

20 This Court also has supplemental jurisdiction over related state dilution and unfair
21 competition in violation of the laws of the State of California pursuant to 28 U.S.C. §§ 1338(b),
22 1367 and the doctrine of supplemental jurisdiction, because such state law claims are so related
23 to the claims within the Court's original jurisdiction that they form part of the same case and
24 controversy.

25 5. This Court has personal jurisdiction over the defendants because they have personally
26 availed themselves by doing substantial business in California.

27 6. Venue is proper in this district under 28 U.S.C. §1391(b) and (c) because a substantial
28 part of the events or omissions giving rise to the claims occurred in this district, and a substantial

1 part of the property that is the subject of the action is situated in this district.

2 **III. INTRADISTRICT ASSIGNMENT**

3 7. This is a trademark case subject to district-wide assignment under Local Rule 3-2(c).

4 **IV. THE PARTIES**

5 8. SOLID 21 is a corporation organized and existing under the laws of the State of Nevada
6 with its principal place of business at 22287 Mulholland Highway Suite 82, Calabasas, CA
7 91302.

8 9. SOLID 21 is informed and believes and on this basis alleges that defendants HUBLOT
9 OF AMERICA, a Florida Corporation; LVMH MOET HENNESSY LOUIS VUITTON, INC.,
10 a Delaware Corporation; LVMH WATCH & JEWELRY USA, INC., a Delaware Corporation,
11 are all wholly owned subsidiaries or agents of LVMH MOET HENNESSY LOUIS VUITTON
12 S.A., a French Corporation, and together they infringe SOLID 21's trademark through the
13 following wholly-owned subsidiary/brand name: HUBLOT and LOUIS VUITTON. SOLID 21
14 is informed and believes and on this basis alleges that defendant LVMH MOET HENNESSY
15 LOUIS VUITTON is a corporation organized and existing under the laws of France. They are
16 infringing Plaintiff's trademark through the following wholly-owned subsidiary/brand name:
17 HUBLOT and LOUIS VUITTON.

18 10. Defendants DOES 1 to 10, inclusive are now, and/or at all times mentioned in this
19 Complaint were individuals and/or are licensed to do business and/or actually doing business in
20 the United States. Plaintiffs do not know the true names and capacities, whether individual,
21 partner or corporate, of DOES 1 to 10, inclusive and for that reason DOES 1 to 10 are sued under
22 such fictitious names pursuant to Federal Rules of Civil Procedure Section 19-1 and federal case
23 law. SOLID 21 will seek leave of court to amend this Complaint to allege such names and
24 capacities as soon as they are ascertained. Defendants, and each of them, are now and/or at all
25 times mentioned in this Complaint were in some manner legally responsible for the events,
26 happening and circumstances alleged in this Complaint. Defendants, and each of them,
27 proximately subjected Plaintiffs to the unlawful practices, wrongs, complaints, injuries and/or
28 damages alleged in this Complaint. Defendants, and each of them, are now and/or at all times

1 mentioned in this Complaint were the agents, servants and/or employees of some or all other
 2 Defendants, and vice-versa, and in doing the things alleged in this Complaint, Defendants are
 3 now and/or at all times mentioned in this Complaint were acting within the course and scope of
 4 that agency, servitude and/or employment. Defendants, and each of them, are now and/or at all
 5 times mentioned in this Complaint were members of and/or engaged in a joint venture,
 6 partnership and common enterprise, and were acting within the course and scope of, and in
 7 pursuance of said joint venture, partnership and common enterprise. Defendants, and each of
 8 them, at all times mentioned in this Complaint concurred and contributed to the various acts and
 9 omissions of each and every one of the other Defendants in proximately causing the complaints,
 10 injuries and/or damages alleged in this Complaint. Defendants, and each of them, at all times
 11 mentioned in this Complaint approved of, condoned and/or otherwise ratified each and every one
 12 of the acts and/or omissions alleged in this Complaint. Defendants, and each of them, at all times
 13 mentioned in this Complaint aided and abetted the acts and omissions of each and every one of
 14 the other Defendants thereby proximately causing the damages alleged in this Complaint.

15 **V. FACTS COMMON TO ALL ALLEGATIONS**

16 11. SOLID 21 is the owner of a United States trademark registration as it relates to fine
 17 jewelry, watches, and related goods and services using its famous RED GOLD® mark, including
 18 Reg. No. 2,793,987 (referred to hereinafter as the "RED GOLD® Registrations") (see Exhibit 1
 19 hereto).

20 12. For over five years, SOLID 21 has been continuously and exclusively using and
 21 promoting its RED GOLD® trademark in connection with the design, manufacture, marketing
 22 and advertising of fine jewelry, watches and related goods and services.

23 13. The RED GOLD® Registration is valid, subsisting and prima facie evidence of the
 24 validity of the mark covered by the RED GOLD® Registration, SOLID 21's ownership of this
 25 mark, and SOLID 21's exclusive right to use the RED GOLD® Registration in commerce
 26 nationwide. The RED GOLD(R) mark for Reg. No. 2,793,987 has become incontestable.

27 14. SOLID 21 has spent significant sums advertising and promoting its products and services
 28 throughout the United States and expanding its business offering goods and related products and

1 services under the distinctive RED GOLD® mark. Solid 21 has spent millions of dollars in
2 promotional efforts to brand RED GOLD(R)®, including direct advertising, aggressive public
3 relations effort and product placement. As part of this effort, Solid 21 has hosted several all-
4 jewelry runway shows highlighting RED GOLD® in cities such as New York, Washington DC,
5 Los Angeles, Lagos, London and Las Vegas. Solid 21 has advertised in several jewelry trade and
6 consumer magazines and has been featured on several television shows, both domestically and
7 internationally. Solid 21 has promoted RED GOLD® on several award shows such as the
8 Academy Awards ("The Oscars"), Billboard Awards, Video Music Awards. Solid 21's celebrity
9 clients have featured RED GOLD® in their songs, music videos and movies. As a result of these
10 efforts and continuous use, the RED GOLD® mark has become famous and associated with the
11 fine jewelry designed, manufactured, marketed and advertised by SOLID 21.

12 15. SOLID 21 both adds to and relies upon the value and goodwill of the RED GOLD® Mark
13 to derive income from its business activities in connection with RED GOLD® and related goods
14 and services.

15 16. SOLID 21 has developed watches and jewelry items using its RED GOLD® mark, all of
16 which have been successfully introduced into the marketplace.

17 17. DEFENDANTS are international watch manufacturers and designers.

18 18. Upon information and belief, at various times after SOLID 21, DEFENDANTS began
19 selling, marketing and advertising fine jewelry utilizing the RED GOLD® mark. Upon
20 information and belief, DEFENDANTS advertised the manufacture and sale of fine jewelry and
21 watches using the RED GOLD® mark in their branding and marketing materials.

22 19. SOLID 21 is informed and believes and on this basis alleges that DEFENDANTS also
23 allowed third parties to promote their product lines of fine jewelry and watches under the RED
24 GOLD® mark.

25 20. DEFENDANTS are national and international watch manufacturers. SOLID 21 is
26 informed and believes and on this basis alleges that DEFENDANTS utilized the RED GOLD®
27 mark in their marketing, advertising and sales of their product line of fine jewelry with full
28 knowledge of SOLID 21 and SOLID 21's use of and prior rights in the RED GOLD® mark with

1 respect to the manufacture, marketing, advertising and sale of fine jewelry, or in the alternative,
2 in negligent disregard for SOLID 21's trademark.

3 21. DEFENDANTS' use of RED GOLD® with respect to their marketing, advertising and
4 sale of their own product line of fine jewelry is directly competitive with Plaintiff's use of RED
5 GOLD® in the same market and is likely to cause confusion, reverse confusion, mistake, and/or
6 deception as to the source of DEFENDANTS' goods and services.

7 22. SOLID 21 pleads the following facts concurrently or in the alternative to the prior facts
8 herein:

9 A. SOLID 21 spent money and effort to develop, formulate, and create a metal alloy
10 gold derivative with an amber hue which it developed, branded and marketed as RED GOLD®.

11 B. SOLID 21 became known and recognized in the fine jewelry and watches
12 marketplace for producing and marketing products including the metal alloy gold derivative with
13 an amber hue which it developed. Similarly products containing the metal alloy gold derivative
14 with an amber hue became associated with the mark RED GOLD® and with SOLID 21.

15 C. The gold with the amber hue developed by SOLID 21, in addition to giving
16 SOLID 21's products a distinctive look had the secondary use of identifying SOLID 21 and its
17 mark RED GOLD®.

18 D. SOLID 21 is informed and believes that in order to capture the goodwill created
19 by SOLID 21's use of the gold alloy color it invented, DEFENDANTS began manufacturing,
20 developing and marketing fine jewelry and watch products using gold treated to create a hue
21 similar to the gold developed by SOLID 21.

22 E. DEFENDANTS have used gold with this hue, which does not exist in gold's
23 natural state, but must be formulated, in order to create confusion in the marketplace and to
24 benefit from its association with luxury and finely made products – a meaning associated with
25 SOLID 21 and RED GOLD(R).

26 **VI. FIRST CLAIM FOR RELIEF (COUNT 1) AGAINST ALL DEFENDANTS**

27 (Trademark Infringement under Lanham Act, 15 U.S.C. § 3231)

28 23. SOLID 21 repeats and re-allege paragraphs 1 through 22 as if fully set forth herein.

1 24. SOLID 21 is the owner of all right, title and interest in and to the RED GOLD®
2 Trademark Registration.

3 25. DEFENDANTS' use of the RED GOLD® mark to market, advertise and sell their
4 product line of fine jewelry and watches is likely to cause confusion, reverse confusion, mistake
5 and/or deception as to the source, sponsorship or approval of DEFENDANTS' product line in the
6 mistaken belief that SOLID 21 has somehow affiliated, connected or associated with
7 DEFENDANTS.

8 26. DEFENDANTS' aforesaid acts constitute trademark infringement of a federally
9 registered trademark in violation of the Lanham Act, 15 U.S.C. § 1114.

10 27. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
11 suffer damage and injury to its business, reputation and good will, and will sustain loss of
12 revenue and profits, while DEFENDANTS profit by their prohibited use.

13 28. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts
14 complained of herein and cause said damages and injury, all to the immediate and irreparable
15 harm of SOLID 21.

16 **VII. FIRST CLAIM FOR RELIEF (COUNT 2) AGAINST ALL DEFENDANTS**

17 (Trademark Infringement under Lanham Act, 15 U.S.C. § 3231)

18 29. SOLID 21 repeats and re-allege paragraphs 1 through 28 as if fully set forth herein.

19 30. SOLID 21 is the owner of all right, title and interest in and to the RED GOLD®
20 Trademark Registration. SOLID 21 has developed an amber hue gold alloy which it uses in the
21 manufacture of its products and which has become associated with the RED GOLD® trademark.

22 31. DEFENDANTS' have tried to mimic RED GOLD® by applying a red hue in the
23 manufacture of its fine jewelry and watches, such use which is likely to cause confusion, reverse
24 confusion, mistake and/or deception as to the source, sponsorship or approval of
25 DEFENDANTS' product line in the mistaken belief that SOLID 21 has somehow affiliated,
26 connected or associated with DEFENDANTS.

27 32. DEFENDANTS' aforesaid acts constitute trademark infringement of a federally
28 registered trademark in violation of the Lanham Act, 15 U.S.C. § 1114.

1 33. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
2 suffer damage and injury to its business, reputation and good will, and will sustain loss of
3 revenue and profits, while DEFENDANTS profit by their prohibited use.

4 34. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts
5 complained of herein and cause said damages and injury, all to the immediate and irreparable
6 harm of SOLID 21.

7 **VIII. SECOND CLAIM FOR RELIEF (COUNT 1) AGAINST ALL DEFENDANTS**

8 (Trademark Infringement under Lanham Act, 15 U.S.C. § 4334)

9 35. SOLID 21 repeats and re-alleges paragraphs 1 through 26 and 29 through 34 as if fully set
10 forth herein.

11 36. DEFENDANTS' use of the RED GOLD® mark to market, advertise and sell their
12 product line of fine jewelry is likely to cause confusion, reverse confusion, mistake or deception
13 as to the source, sponsorship or approval of DEFENDANTS' product line in the mistaken belief
14 that SOLID 21 has somehow affiliated, connected or associated with DEFENDANTS.

15 37. DEFENDANTS' aforesaid acts constitute trademark infringement in violation of the
16 Lanham Act, 15 U.S.C. § 1125(a).

17 38. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
18 suffer damage and injury to their business, reputation and good will, and has and will sustain loss
19 of revenues and profits, while DEFENDANTS profit by their prohibited use.

20 39. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts
21 complained of herein and cause said damages and injury, all to the immediate and irreparable
22 harm of Plaintiffs.

23 **IX. SECOND CLAIM FOR RELIEF (COUNT 2) AGAINST ALL DEFENDANTS**

24 (Trademark Infringement under Lanham Act, 15 U.S.C. § 4334)

25 40. SOLID 21 repeats and re-alleges paragraphs 1 through 29 and 32 through 39 as if fully set
26 forth herein.

27 41. DEFENDANTS' use of the amber hue gold alloy developed by SOLID 21 and related to
28 its RED GOLD® Mark, to market, advertise and sell their product line of fine jewelry is likely to

1 cause confusion, reverse confusion, mistake or deception as to the source, sponsorship or
2 approval of DEFENDANTS' product line in the mistaken belief that SOLID 21 has somehow
3 affiliated, connected or associated with DEFENDANTS.

4 42. DEFENDANTS' aforesaid acts constitute trademark infringement in violation of the
5 Lanham Act, 15 U.S.C. § 1125(a).

6 43. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
7 suffer damage and injury to their business, reputation and good will, and has and will sustain loss
8 of revenues and profits, while DEFENDANTS profit by their prohibited use.

9 44. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts
10 complained of herein and cause said damages and injury, all to the immediate and irreparable
11 harm of Plaintiffs.

12 **X. THIRD CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

13 (Unfair Competition under the Lanham Act, 15 U.S.C. § 1125(a))

14 45. SOLID 21 repeats and re-alleges paragraphs 1 through 44 as if fully set forth herein.

15 46. Through extensive, continuous and exclusive use for over four years, SOLID 21 is the
16 owner of all rights, title and interest in and to, and has acquired secondary meaning in, the
17 distinctive RED GOLD® Mark for its manufacture, marketing, advertising and sale of fine
18 jewelry, watches, and related goods and services. For the purpose of this cause of action, the
19 mark being the words RED GOLD® used in this order "RED GOLD®" and/or alternatively the
20 amber hue gold alloy created and devised by SOLID 21.

21 47. Through SOLID 21's ownership of the RED GOLD® Mark and reliance on the value and
22 goodwill of the RED GOLD® Mark, Plaintiff maintains a financial interest in its exclusive use of
23 the RED GOLD® Marks.

24 48. DEFENDANTS' use of the RED GOLD® Mark to market, advertise and sell their
25 product line of fine jewelry and watches is likely to cause confusion, reverse confusion, mistake
26 or deception as to the source, sponsorship or approval of DEFENDANTS' product line in the
27 mistaken belief that SOLID 21 has somehow affiliated, connected or associated with
28 DEFENDANTS.

1 49. DEFENDANTS' aforesaid acts constitute unfair competition with SOLID 21 in violation
2 of the Lanham Act, 15 U.S.C. § 1125(a).

3 50. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
4 suffer damage and injury to its business, reputation and good will, and will sustain loss of
5 revenues and profits, while DEFENDANTS profit by their prohibited use.

6 51. Unless and until enjoined by this Court, DEFENDANTS' will continue to perform the
7 acts complained of herein and cause said damages and injury, all to the immediate and
8 irreparable harm of Plaintiffs.

9 **XI. FIFTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

10 (COMMON LAW TRADEMARK INFRINGEMENT)

11 52. SOLID 21 repeats and re-alleges paragraphs 1 through 51 as if fully set forth herein.

12 53. Defendants acts alleged herein and specifically, without limitation, Defendants' use of the
13 RED GOLD® mark, infringe SOLID 21's exclusive trademark rights in the RED GOLD® mark,
14 in violation of the common law.

15 54. As a result of Defendants' acts as alleged above, SOLID 21 has incurred damages in an
16 amount to be proven at trial consisting of, among other things, diminution in the value of the
17 goodwill associated with the RED GOLD® mark.

18 **XII. SIXTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

19 (Unfair Competition under California Business & Professions Code § 17200 et seq.)

20 55. SOLID 21 repeats and re-alleges paragraphs 1 through 54 as if fully set forth herein.

21 56. Through SOLID 21's ownership of the RED GOLD® Mark and reliance on the value and
22 goodwill of the RED GOLD® Mark, Plaintiff maintains a financial interest in its exclusive use of
23 the RED GOLD® Marks. For the purpose of this cause of action, the mark being the words RED
24 GOLD® used in this order "RED GOLD®" and/or alternatively the amber hue gold alloy created
25 and devised by SOLID 21.

26 57. DEFENDANTS' use of the RED GOLD® mark to market, advertise and sell their
27 product line of fine jewelry is likely to cause confusion, reverse confusion, mistake or deception
28 as to the source, sponsorship or approval of DEFENDANTS' product line in the mistaken belief

1 that SOLID 21 has somehow affiliated, connected or associated with DEFENDANTS.

2 58. DEFENDANTS' aforesaid acts constitute unfair competition with Plaintiff within the
3 meaning of California Business and Professions Code § 17200.

4 59. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
5 suffer damage and injury to their business, reputation and good will, and will sustain loss of
6 revenues and profits, while DEFENDANTS profit by their prohibited use.

7 60. Pursuant to California Business & Professions Code § 17203, Cisco is entitled
8 to preliminary and permanent injunctive relief ordering DEFENDANTS and each of them to
9 cease this unfair competition, as well as disgorgement of all of DEFENDANTS' profits
10 associated with this unfair competition. Unless and until enjoined by this Court, DEFENDANTS
11 will continue to perform the acts complained of herein and cause said damages and injury, all to
12 the immediate and irreparable harm of SOLID 21.

13 **XIII. SEVENTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

14 (Trademark Dilution under the Lanham Act, 15 U.S.C. § 1125(c))

15 61. SOLID 21 repeats and re-allege paragraphs 1 through 60 as if fully set forth herein.

16 62. SOLID 21's RED GOLD® Mark and Registration is a distinctive mark that has become
17 famous, and/or alternatively the amber gold hue created and devised by SOLID 21 is a distinctive
18 mark that has become famous.

19 63. DEFENDANTS' commercial use of the RED GOLD® mark, in whichever form, to
20 market, advertise and sell their product line of luxury wrist watches and fine jewelry is causing
21 dilution of the distinctive quality of the RED GOLD® Mark and Registration, and/or
22 alternatively the amber gold hue created and devised by SOLID 21.

23 64. DEFENDANTS' aforesaid acts constitute trademark dilution in violation of the Lanham
24 Act, 15 U.S.C. § 1125(c).

25 65. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
26 suffer damage and injury to its business, reputation and good will, and will sustain loss of
27 revenues and profits, while DEFENDANTS profit by their prohibited use.

28 66. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts

1 complained of herein and cause said damages and injury, all to the immediate and irreparable
2 harm of SOLID 21.

3 **XIV. EIGHTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

4 (False Description under the Lanham Act, 15 U.S.C. § 1125(a))

5 67. SOLID 21 repeats and re-alleges paragraphs 1 through 66 as if fully set forth herein.

6 68. SOLID 21's RED GOLD® Mark and Registration is a distinctive mark that has become
7 famous, and/or alternatively the amber gold hue created and devised by SOLID 21.

8 69. DEFENDANTS' commercial use of the RED GOLD® mark, in whichever form, to
9 market, advertise and sell their product line of fine jewelry including watches is likely to create
10 confusion, or to cause mistake, or to deceive consumers as to the affiliation, connection or
11 association of SOLID 21's products, or to deceive consumers as to the origin, sponsorship or
12 approval of SOLID 21's products, all in dilution of the distinctive quality of the RED GOLD(R)
13 Mark and Registration, and/or alternatively the RED GOLD(R) hue created and devised by
14 SOLID 21.

15 70. SOLID 21 avers that DEFENDANTS' use of the term RED GOLD® comprises a false
16 description or representation of such business or products under 15 U.S.C. § 1125(a) (Section
17 43(a) of the Lanham Act).

18 71. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
19 suffer damage and injury to its business, reputation and good will, and will sustain loss of
20 revenues and profits, while DEFENDANTS profit by their prohibited use.

21 **XV. NINTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

22 (Trademark Dilution under California Business and Professions Code 14330)

23 72. SOLID 21 repeats and realleges paragraphs 1 through 71 as if fully set forth herein.

24 73. SOLID 21 is the owner of the famous and distinctive RED GOLD® Mark and
25 Registration, and/or alternatively the amber gold hue created and devised by SOLID 21.

26 74. DEFENDANTS' commercial use of the RED GOLD® mark, in whichever form, to
27 market, advertise and sell their product line of fine jewelry is causing likelihood of injury to
28 business reputation or of dilution of the distinctive quality of the RED GOLD® Mark and

1 Registration.

2 75. DEFENDANTS' aforesaid acts constitute trademark dilution in violation of California
3 Business and Professions Code 14330.

4 76. By reason of DEFENDANTS' aforesaid acts, SOLID 21 has suffered and will continue to
5 suffer damage and injury to its business, reputation and good will, and will sustain loss of
6 revenues and profits, while DEFENDANTS profit by their prohibited use.

7 77. Unless and until enjoined by this Court, DEFENDANTS will continue to perform the acts
8 complained of herein and cause said damages and injury, all to the immediate and irreparable
9 harm of SOLID 21.

10 **XVI. TENTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS**

11 (Declaratory Relief)

12 78. SOLID 21 repeats and realleges paragraphs 1 through 77 as if fully set forth herein.

13 79. An actual controversy has arisen and now exists relating to the rights and duties of the
14 parties herein in the RED GOLD® Mark for which judicial determination is required.

15 80. SOLID 21 is and has been, for over five years, the owner of the RED GOLD® mark as
16 evidenced by, among other things, the RED GOLD® Registrations.

17 81. SOLID 21 has taken all necessary steps to perfect its RED GOLD® Registrations and has
18 filed all items necessary to make the RED GOLD® mark incontestable.

19 82. SOLID 21 has also devised and created a gold alloy with an amber hue, which it has
20 branded and marketed as "RED GOLD®" such a shade and hue which does not exist in gold's
21 natural state. This hue is also a mark of SOLID 21.

22 83. DEFENDANTS and each of them have infringed upon SOLID 21's rights by, among
23 other things, using the "RED GOLD®" mark to describe and market its products, and/or
24 alternatively, by trying to duplicate the amber hue alloy gold developed and devised by SOLID
25 21, for use with their products.

26 84. As such a judicial determination is needed setting forth the respective rights, interests,
27 and duties of all parties to this action. Specifically, SOLID 21 seeks the following declaratory
28 relief: (1) that its RED GOLD® Registrations owned by SOLID 21 be deemed incontestable in

1 accordance with 15 USC §1065; (2) that the RED GOLD® amber hue alloy is an incontestable
2 mark owned by SOLID 21; and (3) that DEFENDANTS, each or some of them, acted in bad faith
3 in their infringing use of the RED GOLD® mark and/or in the alternative the RED GOLD®
4 amber hue alloy devised and created by SOLID 21.

5 **XVII. PRAYER FOR RELIEF**

6 WHEREFORE, SOLID 21 prays that the Court award the following relief:

7 1. That DEFENDANTS, and their agents, officers, employees, representatives, successors,
8 assigns, attorneys and all other persons acting for, with, by, through or under authority from
9 DEFENDANTS, and each of them, be preliminarily and permanently enjoined from:(a) using
10 SOLID 21's trademark depicted in Exhibit 1, or any colorable imitation thereof; (b) using any
11 trademark that imitates or is confusingly similar to or in anyway similar to SOLID 21's
12 trademark RED GOLD®, or that is likely to cause confusion, mistake, deception, or public
13 misunderstanding as to the origin of SOLID 21's products or their connectedness to
14 DEFENDANTS, and each of them.

15 2. That DEFENDANTS, and each of them, be required to file with the Court and serve on
16 SOLID 21 within thirty (30) days after entry of the Injunction, a report in writing under oath
17 setting forth in detail the manner and form in which DEFENDANTS, and each of them, have
18 complied with the Injunction;

19 3. That, pursuant to 15 U.S.C. § 1117, DEFENDANTS be held liable for all damages
20 suffered by SOLID 21 resulting from the acts alleged herein;

21 4. That, pursuant to 15 U.S.C. § 1117, DEFENDANTS, and each of them, be compelled to
22 account to SOLID 21, and that SOLID 21 be awarded, for any and all profits, gains, and
23 advantages derived by DEFENDANTS, and each of them, from its illegal acts complained of
24 herein;

25 5. That DEFENDANTS be ordered pursuant to 15 U.S.C. § 1118 to deliver up for
26 destruction product inventory (including watches and jewelry) all containers, labels, signs, prints,
27 packages, wrappers, receptacles, advertising, promotional material or the like in possession,
28 custody or under the control of DEFENDANTS bearing a trademark found to infringe SOLID

1 21's RED GOLD® trademark rights, as well as all plates, matrices, and other means of making
2 the same;

3 6. That DEFENDANTS, and each of them, be ordered pursuant to 15 U.S.C. § 1118 to
4 deliver up for destruction all gold and gold products, watches, and jewelry, and the like
5 manipulated with an amber hue alloy hue to resemble and mimic the RED GOLD® amber hue
6 alloy gold hue, in possession, custody or under the control of DEFENDANTS, and each of them,
7 bearing a trademark found to infringe SOLID 21's RED GOLD® trademark rights, as well as all
8 plates, matrices, and other means of making the same;

9 7. That the Court declare this to be an exceptional case and award SOLID 21 its full costs
10 and reasonable attorneys' fees pursuant to 15 U.S.C. §§ 1117(a) and 1125(c), and award SOLID
11 21 punitive and treble damages due to DEFENDANTS' willful and intentional acts of trademark
12 infringement, trademark dilution and unfair competition;

13 8. Injunctive relief prohibiting DEFENDANTS, and each of them, from engaging in the
14 unlawful, unfair, deceptive, and misleading business practices described herein;

15 9. Restoration of all money gained by DEFENDANTS, and each of them, by wrongly using
16 the unlawful, unfair, deceptive, and misleading business practices described in this Complaint;

17 10. That it be determined that SOLID 21's RED GOLD® Registrations are incontestable;

18 11. That it be determined that SOLID 21's RED GOLD® amber hue alloy is an incontestable
19 mark owned by SOLID 21;

20 12. That it be determined that DEFENDANTS, each or some of them, acted in bad faith in
21 their infringing use of the RED GOLD® mark and/or in the alternative the RED GOLD® amber
22 hue alloy devised and created by SOLID 21

23 13. That the Court grant Plaintiff any other remedy to which it may be entitled as provided
24 for in 15 U.S.C. §§ 1116 and 1117 or under state law;

25 14. Interest on the above-requested damages;

26 15. Costs of this action and,

27 ///

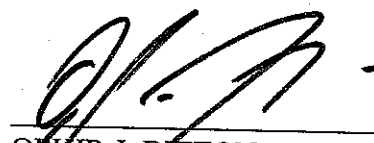
28 ///

1 16. For such and other further relief that the court deems just and p.

2 Dated: January 12, 2011

RESPECTFULLY SUBMITTED:

BITTON & ASSOCIATES

3
4
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6
7 

8 OPHIR J. BITTON
9 Attorneys for Plaintiff SOLID 21, INC.

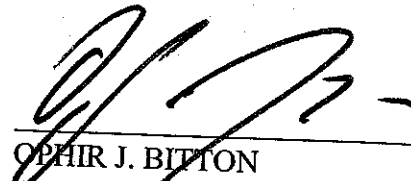
DEMAND FOR TRIAL

Pursuant to *Federal Rule of Civil Procedure* §38(b) SOLID 21 hereby
jury.

Dated: January 12, 2011

RESPECTFULLY SUBMITTED:

BITTON & ASSOCIATES



OPHIR J. BITTON

Attorneys for Plaintiff SOLID 21, INC.

EXHIBIT 1

The United States of America



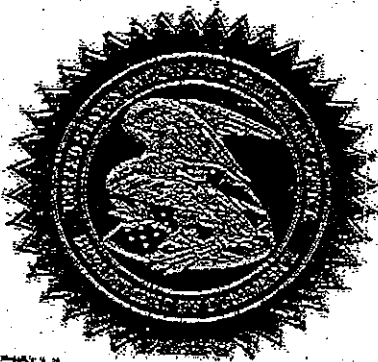
CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



A handwritten signature in cursive script, likely of the Director of the United States Patent and Trademark Office, is positioned to the right of the seal.

Director of the United States Patent and Trademark Office

Requirements for Maintaining a Federal Trademark Registration

SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. §1058, upon the expiration of the following time periods:

- i) At the end of 6 years following the date of registration.
- ii) At the end of each successive 10-year period following the date of registration.

Failure to file a proper Section 8 Affidavit at the appropriate time will result in the cancellation of the registration.

SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. §1059, at the end of each successive 10-year period following the date of registration.

Failure to file a proper Application for Renewal at the appropriate time will result in the expiration of the registration.

No further notice or reminder of these requirements will be sent to the Registrant by the Patent and Trademark Office. It is recommended that the Registrant contact the Patent and Trademark Office approximately one year before the expiration of the time periods shown above to determine the requirements and fees for the filings required to maintain the registration.

Int. Cl.: 14

Prior U.S. Cls.: 2, 27, 28 and 50

United States Patent and Trademark Office

Reg. No. 2,793,987

Registered Dec. 16, 2003

**TRADEMARK
PRINCIPAL REGISTER**

RED GOLD

SOLID 21 INCORPORATED (NEVADA COR-
PORATION)
315 WEST 9TH STREET SUITE 1211
LOS ANGELES, CA 90015

CLIPS AND PEGS AND EARRINGS, IN CLASS 14
(U.S. CLS. 2, 27, 28 AND 50).

FIRST USE 12-13-1989; IN COMMERCE 12-13-1989.


FOR: FINE JEWELRY MADE OF A SPECIAL
ALLOYING OF GOLD WITH A DISTINCT COLOR
MADE INTO FINE JEWELRY, NAMELY,
WATCHES, NECKLACES, BRACELETS, RINGS,
ANKLETS, CUFF LINKS, ORNAMENTAL HAIR
PINS, BELT BUCKLES OF PRECIOUS METAL, THE

SER. NO. 76-434,708, FILED 7-25-2002.

ALICE SUE CARRUTHERS, EXAMINING ATTOR-
NEY

EXHIBIT 2

Side - 1

	NOTICE OF ACCEPTANCE AND ACKNOWLEDGEMENT OF §§8 & 15 DECLARATION MAILING DATE: Aug 21, 2009
<p>The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force. For further information about this notice, visit our website at: http://www.uspto.gov. To review information regarding the referenced registration, go to http://tarr.uspto.gov.</p>	
REG NUMBER: MARK: OWNER:	2793987 RED GOLD Solid 21 Incorporated

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE COMMISSIONER FOR TRADEMARKS P.O. BOX 1451 ALEXANDRIA, VA 22313-1451	FIRST-CLASS MAIL U.S. POSTAGE PAID
Christopher Aire Solid 21 Incorporated 22287 Muholland Highway, suite 82 CALABASAS, CA 91302	

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

NOTICE OF ASSIGNMENT TO UNITED STATES MAGISTRATE JUDGE FOR DISCOVERY

This case has been assigned to District Judge J. Spencer Letts and the assigned discovery Magistrate Judge is Jacqueline Chooljian.

The case number on all documents filed with the Court should read as follows:

CV11- 468 JSL (JCx)

Pursuant to General Order 05-07 of the United States District Court for the Central District of California, the Magistrate Judge has been designated to hear discovery related motions.

The United States District Judge assigned to this case will review all filed discovery motions and thereafter, on a case-by-case or motion-by-motion basis, may refer discovery related motions to the Magistrate Judge for hearing and determination

=====

NOTICE TO COUNSEL

A copy of this notice must be served with the summons and complaint on all defendants (if a removal action is filed, a copy of this notice must be served on all plaintiffs).

Subsequent documents must be filed at the following location:

☒ **Western Division**
312 N. Spring St., Rm. G-8
Los Angeles, CA 90012

☐ **Southern Division**
411 West Fourth St., Rm. 1-053
Santa Ana, CA 92701-4516

☐ **Eastern Division**
3470 Twelfth St., Rm. 134
Riverside, CA 92501

Failure to file at the proper location will result in your documents being returned to you.

Name & Address:

Ophir J. Bitton SBN: 204310
 BITTON & ASSOCIATES
 12080 Ventura Place, Suite D
 Studio City, CA 91604
 Tel. No. 818-524-1223

UNITED STATES DISTRICT COURT
 CENTRAL DISTRICT OF CALIFORNIA

Solid 21, Inc., a Nevada Corporation headquartered in
 Los Angeles, California,

PLAINTIFF(S)

v.

[See Attachment]

DEFENDANT(S).

CASE NUMBER

CV11 468 JSL (JCL)

SUMMONS

TO: DEFENDANT(S): _____

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it), you must serve on the plaintiff an answer to the attached ☒ complaint ☐ amended complaint ☐ counterclaim ☐ cross-claim or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff's attorney, Bitton & Associates, whose address is 12080 Ventura Place, Suite D, Studio City, CA 91604 USA. If you fail to do so, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

Dated: 1-14-11

Clerk, U.S. District Court

By: _____

CHRIS SAWYER

Deputy Clerk

(Seal of the Court)

[Use 60 days if the defendant is the United States or a United States agency, or is an officer or employee of the United States. Allowed 60 days by Rule 12(a)(3)].

ATTACHMENT

(SUMMONS)

PLAINTIFF	DEFENDANTS
SOLID 21, INC. , a Nevada Corporation headquartered in Los Angeles, California,	HUBLOT OF AMERICA, INC. , a Florida Corporation; LVMH MOET HENNESSY LOUIS VUITTON, INC. , a Delaware Corporation; LVMH WATCH & JEWELRY USA, INC. , a Delaware Corporation; LVMH MOET HENNESSY LOUIS VUITTON S.A. , a French Corporation; and DOES 1-10 , inclusive

EXHIBIT B

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 LOS ANGELES, CA 90064
 TELEPHONE (310) 478-3780

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sy@ymlaw.net, dar@ymlaw.net
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(admitted pro hac vice)
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(admitted pro hac vice)
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 FROSS ZELNICK LEHRMAN & ZISSU, P.C.
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 New York, NY 10017
 Tel.: (212) 813-5900; Fax: (212) 813-5901

Attorneys for Defendants,
 HUBLOT OF AMERICA,
 LVMH MOET HENNESSY LOUIS
 VUITTON, INC., and LVMH
 WATCH & JEWELRY USA, INC.

**UNITED STATES DISTRICT COURT
 CENTRAL DISTRICT OF CALIFORNIA**

SOLID 21, INC., a Nevada Corporation
 headquartered in Los Angeles, California,

 Plaintiff,

vs.

HUBLOT OF AMERICA, a Florida
 Corporation; LVMH MOET HENNESSY
 LOUIS VUITTON, INC. a Delaware
 Corporation; LVMH WATCH & JEWELRY
 USA, INC., a Delaware Corporation; LVMH
 MOET HENNESSY LOUIS VUITTON S.A.,
 a French Corporation; and DOES 1- 10,
 inclusive,

DEFENDANTS.

Case No.: CV11-468-DMG (JCx)

*[Assigned to Judge Dolly M. Gee in
 Courtroom 7]*

**DEFENDANTS HUBLOT OF AMERICA,
 LVMH MOET HENNESSY LOUIS
 VUITTON, INC. AND LVMH
 WATCH & JEWELRY USA, INC.'S
 ANSWER TO COMPLAINT AND
 COUNTERCLAIMS
 (Jury Trial Demanded)**

Action Filed: January 14, 2011

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LOS ANGELES, CA 90064
TELEPHONE (310) 478-3780

1 Defendants Hublot of America, LVMH Moet Hennessy Louis Vuitton, Inc. and LVMH
2 Watch & Jewelry USA, Inc. (collectively, the “Served Defendants”), by their undersigned
3 counsel, answer the Complaint as amended by Order dated February 24, 2011 (Docket No. 16) of
4 Plaintiff Solid 21, Inc. (“Plaintiff”) as follows:

5
6 **I. RESPONSE TO NATURE OF THE ACTION**

7 1. The Served Defendants deny the allegations in paragraph 1 of the Complaint,
8 except admit that the Complaint purports to set forth the claims summarized in that paragraph.

9 2. Paragraph 2 of the Complaint sets forth conclusions of law to which no response
10 is required. To the extent a response is deemed to be required, said allegations are denied.

11 3. The Served Defendants deny the allegations in paragraph 3 of the Complaint,
12 except admit that Plaintiff purports to seek the claims for relief summarized in that paragraph.

13
14 **II. RESPONSE TO JURISDICTION AND VENUE**

15 4. The Served Defendants admit the allegations regarding subject matter jurisdiction
16 in paragraph 4 of the Complaint, but deny that Plaintiff’s claims have any validity.

17 5. The Served Defendants deny the allegations in paragraph 5 of the Complaint, but
18 do not contest that this Court has personal jurisdiction over them.

19 6. The Served Defendants deny the allegations in paragraph 6 of the Complaint, but
20 do not contest venue in this district.

21
22 **III. RESPONSE TO INTRADISTRICT ASSIGNMENT**

23 7. Paragraph 7 of the Complaint sets forth conclusions of law to which no response
24 is required. To the extent a response is deemed to be required, said allegations are denied.

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IV. RESPONSE TO THE PARTIES

8. The Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 of the Complaint.

9. The Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations regarding LVMH Moet Hennessy Louis Vuitton S.A. in paragraph 9 of the Complaint. The Served Defendants deny the allegations regarding themselves in paragraph 9 of the Complaint, except admit that Hublot of America is a corporation organized and existing under the laws of the State of Florida, that LVMH Moet Hennessy Louis Vuitton, Inc. is a corporation organized and existing under the laws of the State of Delaware, and that LVMH Watch & Jewelry USA, Inc. is a corporation organized and existing under the laws of the State of Delaware.

10. The Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 10 of the Complaint.

V. RESPONSE TO FACTS COMMON TO ALL ALLEGATIONS

11. The Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 11 of the Complaint.

12. The Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 12 of the Complaint, except deny that Plaintiff has valid trademark rights in the words, "red gold."

13. Paragraph 13 of the Complaint sets forth conclusions of law to which no response is required. To the extent a response is deemed to be required, the Served Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in

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1 paragraph 13 of the Complaint, except deny that Plaintiff has valid trademark rights in the words,
2 “red gold.”

3 14. The Served Defendants are without knowledge or information sufficient to form a
4 belief as to the truth of the allegations in paragraph 14 of the Complaint, except deny that the
5 words, “red gold,” are distinctive, deny that such words have become famous, and deny that such
6 words are associated with the jewelry designed, manufactured, marketed or advertised by
7 Plaintiff.
8

9 15. The Served Defendants are without knowledge or information sufficient to form a
10 belief as to the truth of the allegations in paragraph 15 of the Complaint, except deny that
11 Plaintiff has valid trademark rights in the words, “red gold.”
12

13 16. The Served Defendants are without knowledge or information sufficient to form a
14 belief as to the truth of the allegations in paragraph 16 of the Complaint, except deny that
15 Plaintiff has valid trademark rights in the words, “red gold.”
16

17 17. To the extent the allegations in paragraph 17 of the Complaint are directed to
18 defendants other than the Served Defendants, the Served Defendants are without knowledge or
19 information sufficient to form a belief as to such allegations. LVMH Moet Hennessy Louis
20 Vuitton, Inc. denies that it is an international watch manufacturer or designer. Hublot of
21 America and LVMH Watch & Jewelry USA, Inc. admit that they are United States-based
22 companies that sell watch products both domestically and abroad.

23 18. To the extent the allegations in paragraph 18 of the Complaint are directed to
24 defendants other than the Served Defendants, the Served Defendants are without knowledge or
25 information sufficient to form a belief as to such allegations. To the extent such allegations are
26

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1 directed to the Served Defendants, the Served Defendants deny the allegations in paragraph 18 of
 2 the Complaint.

3 19. To the extent the allegations in paragraph 19 of the Complaint are directed to
 4 defendants other than the Served Defendants, the Served Defendants are without knowledge or
 5 information sufficient to form a belief as to such allegations. To the extent such allegations are
 6 directed to the Served Defendants, the Served Defendants deny the allegations in paragraph 19 of
 7 the Complaint.
 8

9 20. To the extent the allegations in paragraph 20 of the Complaint are directed to
 10 defendants other than the Served Defendants, the Served Defendants are without knowledge or
 11 information sufficient to form a belief as to such allegations. To the extent such allegations are
 12 directed to the Served Defendants, the Served Defendants deny the allegations in paragraph 20 of
 13 the Complaint, except Hublot of America and LVMH Watch & Jewelry USA, Inc. admit that
 14 they are United States-based companies that sell watch products both domestically and abroad.
 15

16 21. Paragraph 21 of the Complaint sets forth conclusions of law to which no response
 17 is required. To the extent a response is deemed to be required, said allegations are denied.
 18

19 22. Paragraph 22 and its subparagraphs A through E are denied as follows:

20 A. The Served Defendants are without knowledge or information sufficient to form a
 21 belief as to the truth of the allegations in subparagraph A of paragraph 22 of the Complaint.

22 B. The Served Defendants deny the allegations in subparagraph B of paragraph 22 of
 23 the Complaint.

24 C. The Served Defendants deny the allegations in subparagraph C of paragraph 22 of
 25 the Complaint.
 26
 27
 28

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1 D. The Served Defendants deny the allegations in subparagraph D of paragraph 22 of
2 the Complaint.

3 E. The Served Defendants deny the allegations in subparagraph E of paragraph 22 of
4 the Complaint.

5
6 **VI. RESPONSE TO FIRST CLAIM FOR RELIEF (COUNT 1) AGAINST ALL
DEFENDANTS (Trademark Infringement under Lanham Act, 15 U.S.C. § 3231)**

7 23. The Served Defendants respond in the manner set forth above to those paragraphs
8 incorporated by reference in paragraph 23 of the Complaint.

9 24. The Served Defendants deny the allegations in paragraph 24 of the Complaint.

10 25. The Served Defendants deny the allegations in paragraph 25 of the Complaint.

11 26. The Served Defendants deny the allegations in paragraph 26 of the Complaint.

12 27. The Served Defendants deny the allegations in paragraph 27 of the Complaint.

13 28. The Served Defendants deny the allegations in paragraph 28 of the Complaint.

14
15 **VII. RESPONSE TO FIRST CLAIM FOR RELIEF (COUNT 2) AGAINST ALL
16 DEFENDANTS (Trademark Infringement under Lanham Act, 15 U.S.C. § 3231)**

17 29. The allegations in paragraph 29 of the Complaint have been stricken, and
18 Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February
19 24, 2011 (Docket No. 16).

20 30. The allegations in paragraph 30 of the Complaint have been stricken, and
21 Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February
22 24, 2011 (Docket No. 16).

23 31. The allegations in paragraph 31 of the Complaint have been stricken, and
24 Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February
25 24, 2011 (Docket No. 16).

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11150 WEST OLYMPIC BOULEVARD, SUITE 900
LOS ANGELES, CA 90064
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32. The allegations in paragraph 32 of the Complaint have been stricken, and Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February 24, 2011 (Docket No. 16).

33. The allegations in paragraph 33 of the Complaint have been stricken, and Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February 24, 2011 (Docket No. 16).

34. The allegations in paragraph 34 of the Complaint have been stricken, and Plaintiff's First Claim, Count 1, has been dismissed with prejudice. *See* Order dated February 24, 2011 (Docket No. 16).

VIII. RESPONSE TO SECOND CLAIM FOR RELIEF (COUNT 1) AGAINST ALL DEFENDANTS (Trademark Infringement under Lanham Act, 15 U.S.C. § 4334)

35. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 35 of the Complaint.

36. The Served Defendants deny the allegations in paragraph 36 of the Complaint.

37. The Served Defendants deny the allegations in paragraph 37 of the Complaint.

38. The Served Defendants deny the allegations in paragraph 38 of the Complaint.

39. The Served Defendants deny the allegations in paragraph 39 of the Complaint.

IX. RESPONSE TO SECOND CLAIM FOR RELIEF (COUNT 2) AGAINST ALL DEFENDANTS (Trademark Infringement under Lanham Act, 15 U.S.C. § 4334)

40. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 40 of the Complaint.

41. The Served Defendants deny the allegations in paragraph 41 of the Complaint.

42. The Served Defendants deny the allegations in paragraph 42 of the Complaint.

43. The Served Defendants deny the allegations in paragraph 43 of the Complaint.

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44. The Served Defendants deny the allegations in paragraph 44 of the Complaint.

**X. RESPONSE TO THIRD CLAIM FOR RELIEF AGAINST ALL DEFENDANTS
(Unfair Competition under the Lanham Act, 15 U.S.C. § 1125(a))**

45. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 45 of the Complaint.

46. The Served Defendants deny the allegations in paragraph 46 of the Complaint.

47. The Served Defendants deny the allegations in paragraph 47 of the Complaint.

48. The Served Defendants deny the allegations in paragraph 48 of the Complaint.

49. The Served Defendants deny the allegations in paragraph 49 of the Complaint.

50. The Served Defendants deny the allegations in paragraph 50 of the Complaint.

51. The Served Defendants deny the allegations in paragraph 51 of the Complaint.

**XI. RESPONSE TO FIFTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS
(Common Law Trademark Infringement)**

52. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 52 of the Complaint.

53. The Served Defendants deny the allegations in paragraph 53 of the Complaint.

54. The Served Defendants deny the allegations in paragraph 54 of the Complaint.

**XII. SIXTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS (Unfair
Competition under California Business & Professions Code § 17200 et seq.)**

55. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 55 of the Complaint.

56. The Served Defendants deny the allegations in paragraph 56 of the Complaint.

57. The Served Defendants deny the allegations in paragraph 57 of the Complaint.

58. The Served Defendants deny the allegations in paragraph 58 of the Complaint.

59. The Served Defendants deny the allegations in paragraph 59 of the Complaint.

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60. The Served Defendants deny the allegations in paragraph 60 of the Complaint.

XIII. SEVENTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS (Trademark Dilution under the Lanham Act, 15 U.S.C. § 1125(c))

61. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 61 of the Complaint.

62. The Served Defendants deny the allegations in paragraph 62 of the Complaint.

63. The Served Defendants deny the allegations in paragraph 63 of the Complaint.

64. The Served Defendants deny the allegations in paragraph 64 of the Complaint.

65. The Served Defendants deny the allegations in paragraph 65 of the Complaint.

66. The Served Defendants deny the allegations in paragraph 66 of the Complaint.

XIV. RESPONSE TO EIGHTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS (False Description under the Lanham Act, 15 U.S.C. § 1125(a))

67. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 67 of the Complaint.

68. The Served Defendants deny the allegations in paragraph 68 of the Complaint.

69. The Served Defendants deny the allegations in paragraph 69 of the Complaint.

70. The Served Defendants deny the allegations in paragraph 70 of the Complaint.

71. The Served Defendants deny the allegations in paragraph 71 of the Complaint.

XV. RESPONSE TO NINTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS (Trademark Dilution under California Business and Professions Code 14330)

72. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 72 of the Complaint.

73. The Served Defendants deny the allegations in paragraph 73 of the Complaint.

74. The Served Defendants deny the allegations in paragraph 74 of the Complaint.

75. The Served Defendants deny the allegations in paragraph 75 of the Complaint.

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76. The Served Defendants deny the allegations in paragraph 76 of the Complaint.

77. The Served Defendants deny the allegations in paragraph 77 of the Complaint.

**XVI. RESPONSE TO TENTH CLAIM FOR RELIEF AGAINST ALL DEFENDANTS
(Declaratory Relief)**

78. The Served Defendants respond in the manner set forth above to those paragraphs incorporated by reference in paragraph 78 of the Complaint.

79. The Served Defendants deny the allegations in paragraph 79 of the Complaint.

80. The Served Defendants deny the allegations in paragraph 80 of the Complaint.

81. The Served Defendants denies the allegations in paragraph 81 of the Complaint.

82. The Served Defendants denies the allegations in paragraph 82 of the Complaint.

83. The Served Defendants deny the allegations in paragraph 83 of the Complaint.

84. The allegation, “(2) that the RED GOLD amber hue alloy is an incontestable mark owned by SOLID 21,” in paragraph 84 of the Complaint has been stricken. *See* Order dated February 24, 2011 (Docket No. 16). The Served Defendants deny the remaining allegations in paragraph 84 of the Complaint.

**FIRST AFFIRMATIVE DEFENSE
(Trademark Invalidity – Genericness)**

85. Under Section 45 of the Lanham Act, 15 U.S.C. § 1127, a generic term may not be registered as a trademark.

86. The words “red gold” are commonly used in the jewelry industry to refer to gold that is of a reddish or pink hue.

87. Plaintiff uses the term “red gold” to describe a species of gold that has a reddish tint, usually resulting from a higher concentration of copper than is found, for example, in “yellow gold” or “white gold.”

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88. Third parties commonly use the phrase “red gold” to describe and refer to a species of gold that has a reddish tint, usually resulting from a higher concentration of copper than is found, for example, in “yellow gold” or “white gold.”

89. The Oxford English dictionary defines “red gold” as “an alloy of gold and copper.”

90. The term, “red gold,” is not understood by the public as identifying Plaintiff as the source or origin of the products in connection with which Plaintiff uses such term.

91. The term, “red gold,” has not been exclusively used by Plaintiff subsequent to the registration of the RED GOLD mark. Third parties also use it and always have used it to refer to gold of a reddish color.

92. The term, “red gold,” is not a valid trademark and is not protectable.

93. Plaintiff’s claims are barred because Plaintiff’s purported RED GOLD mark is generic and therefore invalid and unenforceable against the Served Defendants.

SECOND AFFIRMATIVE DEFENSE (Trade Dress Invalidity – Genericness)

94. Under Section 45 of the Lanham Act, 15 U.S.C. § 1127, a generic designation may not function as a trademark.

95. Plaintiff does not have, and has not alleged that it has, a registered trademark in an amber hued gold alloy.

96. Plaintiff does not exclusively use an amber hued gold alloy for fine jewelry and watches. Third parties also use an amber hued gold alloy for fine jewelry and watches.

97. Amber hued gold alloy is the generic coloring of that particular alloy of gold and cannot be appropriated as a trade mark or as trade dress.

1 98. Plaintiff's claims are barred because Plaintiff's purported use of an amber-hued
2 gold alloy is merely a generic use of a certain color of gold alloy and is, therefore, invalid and
3 unenforceable against the Served Defendants.

4 **THIRD AFFIRMATIVE DEFENSE**
5 **(Trade Dress Invalidity – No Secondary Meaning)**

6 99. Plaintiff's pleaded trade dress is not registered with the United States Patent &
7 Trademark Office.

8 100. For color to function as a trademark under the Lanham Act, the color must have
9 acquired secondary meaning, i.e., it must indicate a single source for the goods at issue.

10 101. The amber hued gold alloy used by Plaintiff is not understood by the public as
11 identifying Plaintiff as the source or origin of products made from an amber hued gold alloy.

12 102. Plaintiff's claims are barred because Plaintiff's purported trademark rights in an
13 amber hued gold alloy are invalid and unenforceable against the Served Defendants.

14 **FOURTH AFFIRMATIVE DEFENSE**
15 **(Trade Dress Invalidity – Amber-Hued Gold Alloy is Functional)**

16 103. Plaintiff's pleaded trade dress is not registered with the United States Patent &
17 Trademark Office.

18 104. For unregistered trade dress, Plaintiff bears the burden of demonstrating that the
19 trade dress is non-functional under Section 43(a)(3) of the Lanham Act.

20 105. Here, given that the amber hue claimed by Plaintiff is merely the functional result
21 of mixing gold and other alloys, the color of the ultimate alloy is functional and cannot be
22 protected as trade dress.

23 106. Plaintiff's claims are barred because Plaintiff's purported trademark rights in an
24 amber hued gold alloy are invalid and unenforceable against the Served Defendants.

FIFTH AFFIRMATIVE DEFENSE
(Fair Use)

107. The Served Defendants are without sufficient knowledge from the Complaint to identify any of their purported uses of RED GOLD, or their purported sale of products made of an amber-hued gold alloy. To the extent, however, that the Served Defendants made any such uses, their uses of the term “red gold” and/or an amber hued gold alloy were fair uses because such terms and alloys were used fairly and in good faith, not as a mark, but only to describe the Served Defendants’ products. *See* 15 U.S.C. § 1115(b)(4).

SIXTH AFFIRMATIVE DEFENSE
(Statute of Limitations)

108. The Served Defendants are without sufficient knowledge from the Complaint to identify any of their purported uses of RED GOLD, or their purported sale of products made of an amber-hued gold alloy. To the extent, however, that the Served Defendants made any such uses, they have long made such uses, and certainly have made such uses prior to three years before the filing of this Complaint. Therefore, Plaintiff’s claims are barred by the statute of limitations.

109. In the alternative, if Plaintiff’s claims are not barred in full by the statute of limitations, any monetary damages sought by Plaintiff that resulted from alleged acts that took place prior to three years before the filing of this Complaint are barred by the statute of limitations.

SEVENTH AFFIRMATIVE DEFENSE
(Laches)

110. The Served Defendants are without sufficient knowledge from the Complaint to identify any of their purported uses of RED GOLD, or their purported sale of products made of an amber-hued gold alloy. To the extent, however, that the Served Defendants made any such

1 uses, they have long made such uses, and certainly have made such uses prior to three years
 2 before the filing of this Complaint. Plaintiff's delay in asserting its rights in RED GOLD and in
 3 trade dress consisting of an amber-hued gold alloy is unreasonable and has caused prejudice to
 4 the Served Defendants. Therefore, Plaintiff's claims are barred by laches.

5 COUNTERCLAIMS

6 **FIRST CLAIM FOR RELIEF** 7 **(FOR DECLARATORY JUDGMENT OF INVALIDITY OF RED GOLD MARK)**

8 111. The Served Defendants incorporate by reference paragraphs 1 through 110 above,
 9 as though fully set forth herein.

10 112. Plaintiff uses the term "red gold" to describe a species of gold that has a reddish
 11 tint, usually resulting from a higher concentration of copper than is found, for example, in
 12 "yellow gold" or "white gold."

13 113. Third parties commonly use and have historically used the phrase "red gold" to
 14 describe and refer to a species of gold that has a reddish tint, usually resulting from a higher
 15 concentration of copper than is found, for example, in "yellow gold" or "white gold."

16 114. The Oxford English dictionary defines "red gold" as "an alloy of gold and
 17 copper."

18 115. The term, "red gold," is not understood by the public as identifying Plaintiff as the
 19 source or origin of the products in connection with which Plaintiff uses such term.

20 116. The term, "red gold," has not been exclusively used by Plaintiff subsequent to the
 21 registration of the RED GOLD mark. Third parties also use it.

22 117. A generic term may not be registered as a trademark.

23 118. A generic term is not protected as a trademark.

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119. Plaintiff's purported RED GOLD mark is a generic term because it refers to the color of the products at issue.

**SECOND CLAIM FOR RELIEF
(FOR CANCELLATION OF REGISTRATION NO. 2,793,987)**

120. The Served Defendants incorporate by reference paragraphs 1 through 119 above, as though fully set forth herein.

121. Pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, this Court may, *inter alia*, "order the cancelation of registrations."

122. Because a generic term may not be registered as a trademark, Plaintiff's Registration No. 2,793,987 for the purported mark, RED GOLD, should be canceled.

**THIRD CLAIM FOR RELIEF
(FOR DECLARATORY JUDGMENT OF INVALIDITY OF PURPORTED AMBER
HUED GOLD ALLOY MARK)**

123. The Served Defendants incorporate by reference paragraphs 1 through 122 above, as though fully set forth herein.

124. Under Section 45 of the Lanham Act, 15 U.S.C. § 1127, a generic designation may not function as a trademark.

125. Plaintiff does not have, and has not alleged that it has, a registered trademark in an amber hued gold alloy.

126. Plaintiff does not exclusively use an amber hued gold alloy for fine jewelry and watches. Third parties also use an amber hued gold alloy for fine jewelry and watches.

127. Amber hued gold alloy is the generic coloring of that particular alloy of gold and cannot be appropriated as a trade mark or as trade dress.

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128. Additionally, for color to function as a trademark under the Lanham Act, the color must have acquired secondary meaning, i.e., it must indicate a single source for the goods at issue.

129. The amber hued gold alloy used by Plaintiff is not understood by the public as identifying Plaintiff as the source or origin of products made from an amber hued gold alloy.

130. Additionally, for unregistered trade dress, Plaintiff bears the burden of demonstrating that the trade dress is non-functional Section 43 (a)(3) of the Lanham Act.

131. Here, given that the amber hue claimed by Plaintiff is merely the functional result of mixing gold and other alloys, the color of the ultimate alloy is functional and cannot be protected as trade dress.

132. For the foregoing reasons, Plaintiff's purported trade dress in an amber hued gold alloy is not a valid trademark and is not protectable.

A JURY TRIAL IS DEMANDED ON ALL CLAIMS SO TRIABLE.

WHEREFORE, the Served Defendants request that this Court:

- (i) Enter judgment in favor of the Served Defendants and against Plaintiff as to all counts of Plaintiff's Complaint;
- (ii) Declare that "red gold" is not a valid trademark because it is generic;
- (iii) Order the cancelation of Plaintiff's Registration No. 2,793,987;
- (v) Declare that the amber hued gold alloy used by Plaintiff is not a valid trademark because it is generic, functional and has not acquired distinctiveness or secondary meaning;
- (vi) Award the Served Defendants their costs and attorneys' fees; and
- (vii) Award the Served Defendants such other relief as this Court deems just and proper.

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1
2 Respectfully submitted,
3 Dated: March 11, 2011 **YOUNGERMAN & McNUTT LLP**

4 By: //Stephen Youngerman//
5 STEPHEN YOUNGERMAN
6 Attorney for Defendants,
7 HUBLOT OF AMERICA ,
8 LVMH MOET HENNESSY LOUIS
9 VUITTON, INC., and LVMH
WATCH & JEWELRY USA, INC.

10 Dated: March 11, 2011 Respectfully submitted,
11 **FROSS, ZELNICK LEHRMAN & ZISSU, P.C.**

12 By: //John Margiotta//
13 JOHN MARGIOTTA
14 LAURA POPP-ROSENBERG
15 ANNA LEIPSIC
16 Attorneys for Defendants, HUBLOT OF AMERICA,
17 LVMH MOET HENNESSY LOUIS VUITTON, INC., and
18 LVMH WATCH & JEWELRY USA, INC.

CERTIFICATE OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 11150 West Olympic Boulevard, Suite 900, Los Angeles, California 90064.

On March 11, 2011, I served the foregoing document described as **DEFENDANTS HUBLOT OF AMERICA, LVMH MOET HENNESSY LOUIS VUITTON, INC. AND LVMH WATCH & JEWELRY USA, INC.'S ANSWER TO COMPLAINT AND COUNTERCLAIMS (Jury Trial Demanded)** on the interested parties in this action as follows:

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☒ (BY ELECTRONIC TRANSFER) I caused all of the pages of the above-entitled document(s) to be uploaded to the U.S. District Court "CM/ECF" System to be sent to the recipients listed herein via electronic transfer (EMAIL) at the respective EMAIL addresses indicated herein.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on March 11, 2011, at Los Angeles, California.

// S //

KATIE YAMASHITA

CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of April 2015 I caused a true and correct copy of the foregoing STIPULATED MOTION TO SUSPEND PROCEEDINGS PENDING RESOLUTION OF CIVIL ACTION to be served upon counsel for Registrant at the following address:

Robert A. Kashfian, Esq.
Ryan D. Kashfian, Esq.
1875 Century Park East, Suite 1340
Los Angeles, CA 90067



John P. Margiotta